

## REMARKS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments and the following remarks.

### **Status of the claims**

Upon entry of the foregoing amendments, claims 1-17 and 23-27 will be pending in the application. Claims 18-22 are canceled presently, since they are drawn to a non-elected invention. No other claims are presently being amended or added.

### **§ 102 rejections**

The Examiner rejected claims 1, 2, 4, 5, 13-17, 23 over West *et al.*, *J. Org. Chem.*, 445-449 (2000), and Northcote *et al.*, U.S. 2002/0193423. Applicants traverse the rejection. Neither of the references anticipates the claimed invention because neither discloses the structures set forth in the rejected claims.

With regard to claim 1, the references fail to disclose the stereochemistry of the claimed compounds. Both the structure on page 5 of Northcote and the structure on page 445 of West depict the stereochemistry of inactive enantiomers, which are not within the scope of the pending claims.

Moreover, the cited references do not inherently disclose the stereochemistry of active enantiomers. For anticipation to occur, a single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the claimed subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention. *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002). When anticipation is based on the inherency of certain limitations not expressly disclosed in an asserted reference, it must be shown that the undisclosed information was known to be present in the subject matter of the reference. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

In the present case, the ordinarily skilled artisan would not find or recognize the proper stereochemistry of an active enantiomer within the cited references. Indeed, the references themselves acknowledge that they depict only relative stereochemistry, and that actual stereochemistry remains unknown. *See West et al.* at 447 and *Northcote et al.* at paragraph [0027]. There are two possibilities for the proper stereochemistry in question, but mere possibilities do not suffice. *Scaltech, Inc. v. Retec/Tetra, LLC*, 178 F.3d 1378, 1384 (Fed. Cir. 1999) (anticipation by inherency requires that *every* element *necessarily* is present in cited art).

Additionally, the description in the cited references of a method for isolating Peloruside A from marine sponges does not inherently anticipate the claimed invention. As the PTO's reviewing court explained in *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1381 (Fed. Cir. 2002), the relevant question is not whether the prior-art process inherently yields the claimed compounds but whether one skilled in the art would have read the cited art as inherently disclosing the claimed compounds; here, whether one skilled in the art would have apprehended, from either cited publication, a compound having the presently recited stereochemistry. Clearly, the answer is "no."

With regard to claim 2, the cited references fail to disclose a synthetic compound. The requirement for a synthetic compound is evident from the stereochemistry at C-13.

With regard to claims 4, 5, 13-17, and 23, the rejection alleges that peloruside A is encompassed by the claims and that the cited references teach peloruside A. For the reasons discussed above, however, such is not the case.

Because the cited references depict compounds having different stereochemistry than the claimed compounds, and because one skilled in the art would not read the cited references as disclosing compounds having the required stereochemistry, Applicants request withdrawal of the anticipation rejection.

**Claim objections**

The Examiner objected to claims 3 and 6-12 as being dependent upon a rejected base claim. Note, however, that these claims are rendered in proper form as independent claims. Accordingly, Applicants respectfully request withdrawal of the objection.

**Allowed claims**

Applicants acknowledge, with thanks, that claims 24-27 are allowed.

**CONCLUSION**

Applicants believe that this application is in condition for allowance, and request favorable reconsideration of it. If the Examiner has any questions or believes that an interview would help to advance prosecution of the application, she may contact the undersigned attorney by telephone.

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extensions under 37 C.F.R. §1.136 and authorize payment of any extension fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 3 April 2006

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

By Stephen A. Bent

Stephen A. Bent  
Attorney for Applicant  
Registration No. 29,768